

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated January 8, 2004, indicated that claims 1, 2, 5-9 and 12-16 are rejected under 35 U.S.C. § 103(a) over *Kagami et al.* (U.S. Pat. No. 5,974,400) and further in view of *Graf et al.* (U.S. Pat. No. 6,349,300); claims 3, 4, 10 and 11 are rejected under 35 U.S.C. § 103(a) over *Graf et al.* in view of *Kagami et al.*; and claims 17-22 are rejected under 35 U.S.C. § 103(a) over *Rose* (U.S. Patent No. 5,930,769) and in view of *Gerber* (U.S. Patent No. 4,843,574). Except for the rejection of claims 17-22, each of these rejections is identical to those presented and previously addressed in connection with the Office Actions dated February 7, 2003, and/or December 18, 2002.

Applicant respectfully traverses the Section 103(a) rejections of claims 1-16 because the instant Office Action merely repeats the rejections presented in the Office Action dated February 7, 2003, without providing any response to the arguments Applicant set forth in the Office Action Response and Amendment filed on April 29, 2003. MPEP § 707.07(f) states:

Where the requirements are traversed, or suspension thereof requested, the examiner should take proper reference thereto in his or her action on the amendment. Where the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it.

In this regard, MPEP § 707.07(f) dictates that the Office Action should take note of Applicant's arguments regarding the impropriety of the asserted combinations and answer the substance of them. This is consistent with the purpose of aiding Applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. § 1.104(a)(2). The Office Action states in paragraph 3 that "Applicant's arguments are considered moot in view of the new art presented. Examiner's prior rejections are maintained." The new art presented is only relied upon in the rejection of new claims 17-22 while the rejections of claims 1-16 were maintained without any new prior art. The Examiner acknowledges this fact in paragraph 3, "Examiner's prior rejections are maintained." As Applicant traversed each of the rejections of claims 1-16 including substantial rationale and the Examiner acknowledges

that the rejections were maintained, the Examiner is required to respond to Applicant's arguments.

This is the third time the Examiner has asserted the same rejections of claims 1, 2, 5-9 and 12-16, and there has been no response to Applicant's arguments. As Applicant pointed out in the Office Action Response and Amendment filed on April 19, 2003, herein incorporated in its entirety, the previous Office Action dated February 7, 2003, also failed to substantively respond to Applicant's arguments. In view of the repeated rationale for the rejections of claims 1-16, Applicant maintains the traversal of claims 1-16 for the reasons set forth in the Office Action Response and Amendment filed on April 19, 2003, and accordingly requests that the rejections be withdrawn.

Applicant respectfully traverses the Section 103(a) rejection of claims 17-22 because the Office Action fails to present a combination of references that teaches each of the claimed limitations. For example, neither reference teaches either of two claimed aspects and, therefore, combining these references could not possibly yield correspondence to the claimed invention. These two example aspects not taught by either reference are a second article selected from an on-line viewer site and a web-linking engine used to determine whether colors of two colored apparel articles match.

The Office Action acknowledges at page 9 that the '769 reference fails to "disclose a second colored apparel article selected by an on-line viewer from the on-line viewer site, the computer-driven web-linking engine adapted to use a color matching criterion to determine whether the first colored apparel article color matches the second colored apparel article color."

The '574 reference fails to teach, for example, a second article being selected from an on-line viewer site and a web-linking engine for a determination as to whether colors of two colored apparel articles match. Instead, the '574 reference teaches an example of a color measuring system as disclosed in the instant Specification. None of the citations to the '574 reference teach the claimed selection of a second article from an on-line viewer site or any determination as to whether colors of two colored apparel articles match. A review of the '574 reference fails to reveal any use of a computer-driven web-linking engine; there is no discussion of linking to the web or any web sites. Moreover, the colored items in the '574 teachings represent original works created by a fashion designer and thus would not be selected from another's on-line site. Further, the '574 reference does not appear to use the

color measuring system to compare and match the colors of two colored apparel articles but rather uses the measuring system to identify a color and use the identifying information to specify dyes necessary to create the color.

Neither reference of the proposed combination corresponds to the above-discussed aspects of the claimed invention. The Examiner acknowledges this with respect to the '769 reference and fails to cite portions of the '574 reference that would overcome the deficiencies in the '769 teachings. Without a showing of complete correspondence between the proposed combination and each of the claimed limitations, the Section 103(a) rejection is improper. Applicant accordingly requests that the rejection be withdrawn.

Moreover, the proposed modification of the '769 reference is improper because the combination of the cited references would frustrate the purpose of the '769 reference. The MPEP states that when a proposed modification would render the teachings being modified unsatisfactory for their intended purpose, then there is no suggestion or motivation to make the proposed modification under 35 U.S.C. § 103(a). *See*, MPEP § 2143.01. The '769 reference is directed to a method for fashion shopping among a set inventory of apparel. *See* title, abstract. The Examiner alleges that the skilled artisan would modify the '769 teachings with those of the '574 reference to be able to customize by comparing styles with different color combinations. However, the '574 reference teaches a method for a fashion designer to alter the colors of proposed fashion designs. Column 2, lines 40-44. The '769 shopper would not customize the colors of the apparel items for sale in the '769 method because the set inventory items are not available in such customized colors. The shopper would not be able to purchase the customized items, thus undermining the shopping function of the '769 reference. To suggest combining the '574 reference's color alteration system with the '769 teachings is untenable. The proposed combination would fail to produce fashion items available for purchase, and therefore, the combination is improper.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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